

REMARKS

Claims 1, 15 and 21 have been amended. Claims 1, 2 and 12-26 remain before the Examiner for reconsideration.

In the Office Action dated June 18, 2003 in the above-referenced application, the Examiner rejected claims 1, 2, and 13-21 under 35 U.S.C. 103(a) "as being unpatentable over Harkness in view of Carney." Specifically, the examiner asserted that:

Harkness discloses a device support member worn around a person's head and an attached laser light (abstract) generating a linear alignment beam of light visible to the person to provide an alignment of the person's body when in position to perform the task as stated in claims 1 and 2 (figs. 2 and 3). Harkness also discloses a cylindrical lens and positions the lens to direct the beam of light as in claim 2 (fig 4 and col 3, lines 20-26). Regarding claims 19 and 20, Harkness does not disclose the device around the chest or hips of the user. Harkness does disclose the device as being interchangeable among different items. However, moving the device from one body part to another is a method of use, which is not relevant to the structure of the device. Harkness discloses a spot of light on the ground and does not disclose a line of light. However, Carney teaches a line of light alignment. One skilled in the art would have modified the invention of Harkness with Carney by changing the spot of light to a line of light to provide a more accurate alignment means for the user.

The Examiner further asserted that Applicant's arguments presented in the Amendment entered on May 16, 2003 were not fully persuasive. Specifically, the Examiner asserted that:

Harkness discloses a device comprising a support member worn on a person's head and a light source comprising a laser. Harkness further discloses a spot on the ground produced by the laser beam but does not disclose a line of light. Carney teaches a line of light produced by a laser beam. Applicant further argues the Harkness reference is used to prevent movement and the present invention is used to achieve the proper alignment. However, the method of using the device is not relevant to apparatus. The structural limitations as claimed

are disclosed by Harkness in view of Carney. Applicant also argues one would not modify the line a spot of light with a line of light. The Examiner disagrees. As shown in the rejection above, Harkness teaches the structural limitations claimed by applicant, except for the line of light produced by the laser. Harkness discloses a spot of light and the secondary reference, Carney, teaches a golfing device with a line of light. Since both references disclose golfing devices it is not clear why applicant would argue the present disclosure is used to reconstruct applicant's invention. Clearly, the present invention is not the first in the golfing industry to include a line of light as taught by Carney.

Applicants respectfully traverse the Examiner's rejection.

Once again, Applicant respectfully asserts that the Examiner's assertion that Harkness discloses "a linear alignment beam of light visible to the person to provide an alignment of the person's body when in position to perform the task" is clearly erroneous. Harkness does not address the problem of determining alignment of any portion of the body the user thereof, and the device of Harkness does not provide any information to the user thereof regarding the alignment of any portion of the person's body. Harkness discloses the use of a light spot projected onto the ground to aid a golfer in observing head movement during a golf swing and not to provide an alignment of the person's body when in position to perform the task. Indeed, the above scope of the invention of Harkness is well set forth in Harkness and summarized succinctly in the abstract of Harkness as follows:

A method for using a light spot projecting aid to observe head movements during a golf swing and to provide a golfer with an explanation (i.e., cause) of the effect manifested as the light spot being moved.

Unlike the present invention, Harkness provides no information to the user thereof of a plane transversing the person's eyes or any other portion of the person's body.

Indeed, the Examiner admits that "Harkness discloses a spot of light on the ground and does not disclose a line of light." Nonetheless, the Examiner asserts that one skilled in the art would modify "the invention of Harkness in light of the disclosure of

Carney by changing the spot of light to a line of light to provide a more accurate alignment means to the user.” However, Harkness is not designed to provided information on alignment of the user’s body, but to provide an indication of head movement. As neither Harkness nor Carney are designed to provide feedback to the user regarding the actual alignment of the user’s body, and neither Harkness nor Carney even address the problem of providing such feedback, there is absolutely no motivation for one skilled in the art to combine the teaching of Harkness with the teaching of Carney to arrive at the present invention. See, for example, Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (P.O. Bd. Appl. 1984) (“The prior art must provide a motivation or reason for a worker in the art without the benefit of appellant’s specification to make the necessary changes in the reference device.”); Schenk v. Norton, 218 USPQ 698, 702 (Fed. Cir. 1983) (“Modification unwarranted by the disclosure of a reference is improper.”); Ex Parte Acosta, 211 USPQ 636, 637 (P.O. Bd. Appls. 1980) (Examiner’s combination of two references is improper where there is no basis in the record from which it can reasonably be inferred that one skilled in the art would have been led or motivated to modify the primary reference in the manner proposed by the Examiner.).

The Examiner further incorrectly asserts that “the method of using the device [of the references] is not relevant to the apparatus” and that “the structural limitations as claimed are disclosed by Harkness in view of Carney.” Initially, the method of use and the stated use/purpose of a device disclosed in a reference is certainly relevant to the combination of that reference with a second reference so as to modify the device of the first reference. In that regard, it is not obvious to one skilled in the art to substantially modify the device of the first reference to achieve another, substantially different method, use or purpose. As body alignment is irrelevant to the stated sole purpose of the device of Harkness (that is, the detection of motion), one skilled in the art would not attempt to modify that device as suggested by the Examiner. Moreover, Carney does not disclose or suggest a means of providing feedback to a person of the actual alignment of any portion that person’s body. Carney merely discloses the propagation of a line of light on the ground to indicate the target line to a particular target

such as a simulated golf hole. Although Carney discloses a target line of light to which a person may attempt to align a portion of the person's body, the person is provided with no indication/feedback of how that portion of the person's body is actually aligned by the device of Carney.

In any event, however, even if one were to combine the source of a line of light disclosed in Carney with the device of Harkness (for which combination there is no motivation in the disclosure of Harkness, Carney or any combination thereof), one would not arrive at the present invention. As clear from the disclosure of Harkness and as demonstrated to the Examiner in the interview of March 4, 2002, the spot of light of Harkness does not even provide information as to the alignment of the cap on the person's head (which need not be aligned with the orientation of the person's head) as the device need not be placed on the cap to project the light in any specific orientation. Converting the spot of light projected by the device of Harkness to a line of light would not provide a line of light generally parallel to the alignment line passing transversely through any portion of the person's body (for example, the eyes, chest or hips) as claimed in the present invention.

It is in the above regard that the Examiner continues to impermissibly ignore an express claim limitation of the present invention. In that regard, the light source of the present invention is attached to the support member in a manner to maintain the light source in a position on the person's head (or other portion of the person's body) such that the alignment beam of light projected upon the surface is generally parallel to an alignment of a plane transversing the person's eyes when the person is in position to perform the task. Applicant has amended the claims to even more clearly set forth this existing limitation. There is absolutely no disclosure in Harkness or Carney, of a support member attachable to the body of a user that is suitable to maintain a source of a generally linear alignment beam of light in a position on the person's body so that the generally linear, alignment beam of light is generally parallel to a line passing transversely through the portion of the person's body. The Examiner cannot continue to impermissibly ignore this express claim limitation. See Ex Parte Murphy and Burford, 217 USPQ 479, 481

(P.O. Bd. Apps. 1982) (“it is error to ignore specific limitations distinguishing over the cited reference”); In re Boe, 505 F.2d 1297, 184 USPQ 38 (CCPA). Applicant has amended the claim

It is for the above reasons that Applicant respectfully asserts that the Examiner is impermissibly using the disclosure of the present application as a guide in attempting to reconstruct the present invention through combination of Harkness and Carney. See, for example, Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc., 21 F. Supp. 2d 366, 371, 48 USPQ2d 1741, 1745 (S.D.N.Y. 1998), aff'd, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000) (“obviousness is not determined as if the designer had hindsight knowledge of the patented design.”). See also Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000) (quoting Dembicza); In re Dembicza, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Combining prior art references without evidence of ... a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.”); C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), rehearing denied & suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed. Cir. 1998) (“The invention that was made ... does not make itself obvious; that suggestion or teaching must come from the prior art.”); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); Fromsom v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination); In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (“rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a

blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”); Sensonics, Inc. v. Aerasonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996) (“The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.”).

Even though, as recognized by the Examiner, both Harkess and Carney disclose devices designed for use in the golf industry, absent some suggestion to one of ordinary skill in Harkness or Carney of the desirability of the claimed combination, one of ordinary skill in the art – without the benefit of Applicant’s specification - would not combine those disclosures, and then further modify the combination, to arrive at the present invention. Applicant is not claiming merely to be “the first in the golf industry to include a line of light” as asserted by the Examiner. Applicant is, however, the first to use an alignment line of light to provide real time feedback to a person of the alignment of a line passing transversely through a portion of the person’s body to provide to the person an indication of the alignment of the portion of the person’s body. To provide such information to the user of the device of the present invention is a substantial improvement in the art of, for example, golf instruction.

The Examiner further indicated that claims 22-26 are objected to “as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims”. However, for the above reasons, the Applicant respectfully asserts that claims 22-26 are allowable in their current form.

In view of the above amendments and remarks, the Applicants respectfully requests that the Examiner withdraw the rejection of the claims, indicate the allowability of the claims, and arrange for an official Notice of Allowance to be issued in due course.

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